

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

*In re* Application of: Michael Joseph Stirniman : Confirmation No.: 5143  
Serial No.: 10/644,054 : Art Unit: 1716  
Filed: 08/20/2003 : Examiner: Sylvia Macarthur  
For: SINGLE DISC VAPOR :  
LUBRICATION

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

The following Pre-Appeal Brief Request for Review and Notice of Appeal are submitted in response to the Advisory Action mailed September 23, 2010. Applicant filed a Response on September 7, 2010, within two months of the July 7, 2010, Final Office Action.

The pending Claims 1-8, 13-15, 28 and 29 are set forth in the Applicant's Response on September 7, 2010.

**ISSUES PRESENTED**

A *prima facie* case of anticipation under 35 U.S.C. §102 was not made because the cited references do not disclose a lubricant vapor source comprising a plurality of threaded holes into which a plurality of primary plugs are screwed therein.

A *prima facie* case of obviousness under 35 U.S.C. §103 was not made because the cited references do not teach or suggest a lubricant vapor source comprising a plurality of threaded holes into which a plurality of primary plugs are screwed therein.

### ARGUMENT

The Examiner has not established a *prima facie* case either of anticipation under 35 U.S.C. §102 or of obviousness under 35 U.S.C. §103. There is no disclosure, teaching, or suggestion in any of the cited references (Branderhorst, Lieher, and Segerstorm) of “the lubricant vapor source comprises a plurality of threaded holes into which the plurality of primary plugs are screwed therein,” as claimed in independent Claim 1. The Examiner’s assertions are without any factual basis or support in the record.

Claim 1 is rejected under 35 USC §102(b) as allegedly being anticipated by Branderhorst et al (US 5,196,064, hereinafter “Branderhorst”) or, in the alternative under 35 USC §103(a) as obvious over Lieher et al (US 6,487,986, hereinafter “Lieher”) in view of Branderhorst or Segerstorm et al (EP 0318071, hereinafter “Segerstorm”).

Claims 2-8, 13-15, 28 and 29 depend from independent Claim 1, and are rejected under 35 USC §103(a) as allegedly being unpatentable over Liehr in view of Branderhorst.

The Applicant’s claimed combination in independent Claim 1 includes a feature not disclosed, taught, or suggested in Branderhorst, Lieher, and Segerstorm, either singly or in combination, of:

the lubricant vapor source comprises a plurality of threaded holes into which the plurality of primary plugs are screwed therein.

The Examiner states in the Advisory Action dated September 23, 2010 (emphasis added), “Since Branderhorst et al fails to specify the use of a lubricant source, the prior art of Liehr et al (US 6,487,986) teaches an elongated vapor source (chamber 1).” As such, Branderhorst fails to teach “the lubricant vapor source,” as recited in Claim 1. For these reasons, Applicants respectfully submit that independent Claim 1 is not anticipated by Branderhorst, thereby overcoming the 35 USC §102(b) rejection of record.

The Examiner has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. The M.P.E.P. states that: “In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met... the prior art reference (or references when combined) must teach or suggest all the claim limitations.” M.P.E.P. §2142.

The Examiner states on Page 3 of the Final Office Action dated July 7, 2010 that the “Branderhorst et al [reference] features an elongated source (bridge plate 170) that comprises a chamber communicating with a plurality of primary plugs (110, 15)) [sic] and threaded holes that primary plugs are screwed into.” Applicants respectfully submit that Branderhorst fails to teach or suggest the features of “the lubricant vapor source comprises a plurality of threaded holes into which the plurality of primary plugs are screwed therein,” as recited in Claim 1.

Applicants respectfully submit that Branderhorst teaches, “[a]s shown in FIG. 2, bridge plate 170 comprises two bores 200 and 210 for receiving bulkheads such as 122 of nozzle assemblies 110 and 150 as shown in FIG. 1.” (col. 4 ln. 66 – col. 5 ln. 1). Thus, as illustrated in Figure 2 Branderhorst’s bores are smooth and not “threaded holes into which the plurality of primary plugs are screwed therein,” as claimed in Claim 1.

Thus, it is clear that a *prima facie* case of obviousness regarding “the lubricant vapor source comprises a plurality of threaded holes into which the plurality of primary plugs are screwed therein,” as claimed in independent Claim 1 has not been met.

Furthermore, the Examiner states in the Advisory Action dated September 23, 2010:

Nuts 123 and 124 have threaded holes to complement the plugs and allow the height adjustment. Branderhorst et al is seen as the primary reference, teaching the claimed structure of the plugs with a drilled hole 128 and two openings (inlet and outlet).

Applicants respectfully submit that Branderhorst fails to teach or suggest the features of “the lubricant vapor source comprises a plurality of threaded holes into which the plurality of primary plugs are screwed therein,” as recited in Claim 1.

Applicants respectfully submit that Branderhorst teaches, “Bulkhead 122 is affixed to bridge plate 170 using standard polypropylene nuts 123 and 124 which are commercially available,” (col. 3 ln. 34 – 36). In addition, the Examiner states on Page 3 of the Final Office Action dated July 7, 2010 that the “Branderhorst et al [reference] features an elongated source (bridge plate 170).” Therefore, Branderhorst teaches that the separate nuts attach the bulkhead to the bridge plate. This is different from the Applicant’s claimed feature of “the lubricant vapor source comprises a plurality of threaded holes into which the plurality of primary plugs are screwed therein,” as recited in Claim 1.

Thus, it is again clear that a *prima facie* case of obviousness regarding “the lubricant vapor source comprises a plurality of threaded holes into which the plurality of primary plugs are screwed therein,” as claimed in independent Claim 1 has not been met.

In addition, Branderhorst teaches away from threaded holes. The MPEP states, “[w]hen the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious. *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1395,” (MPEP 2143).

Applicants respectfully submit that Branderhorst teaches:

Holding cap 121 may then be torqued, and nuts 123 and 124 may be used to finely adjust the position of the tip 129 of nozzle 125 for proper alignment with respect to tip 161 of alignment peg 160. During this fine adjustment, because key 303 resides in keyway 201 and notch 304 of bulkhead 122, bulkhead 122 is prevented from rotating with respect to bridge plate 170.

Thus, Branderhorst adjusts the height of the bulkhead by screwing the nuts and preventing rotation of the bulkhead. Applicants respectfully submit that if the bridge plate was threaded and the bulkhead was screwed therein, it would be impossible to adjust the height of the bulkhead using the nuts without rotating the bulkhead with respect to the bridge plate. Therefore, Branderhorst teaches away from “threaded holes into which the plurality of primary plugs are screwed therein,” as claimed in Claim 1.

Thus, it is yet again clear that a *prima facie* case of obviousness of “the lubricant vapor source comprises a plurality of threaded holes into which the plurality of primary plugs are screwed therein,” as claimed in independent Claim 1 has not been met.

Similarly, Lieher, and Segerstorm do not teach or suggest “the lubricant vapor source comprises a plurality of threaded holes into which the plurality of primary plugs are screwed therein,” as claimed in independent Claim 1.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness for independent Claim 1 as well as Claims 2-8, 13-15, 28 and 29 depending therefrom. Therefore, the claim rejections are reversible error.

***Conclusion***

It is respectfully submitted that the Examiner erred in the attempt to create *prima facie* cases of anticipation under 35 U.S.C. §102 and obviousness under 35 U.S.C. §103 by citing references that do not disclose, teach, or suggest “threaded holes into which the plurality of primary plugs are screwed therein,” as claimed in Claim 1.

In view of the above, it is submitted that Claims 1-8, 13-15, 28 and 29 are in condition for allowance and such action at an early date is solicited.

Respectfully submitted,

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